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EXAMINER

EVANISKO, LESLIE J

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2854

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

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GROUP 2800

Application Number: 10/719,537

Filing Date: November 20, 2003

Appellant(s): HOSEY, MICHAEL JACKSON

Stuart K. Whittington, no. 45,215

For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 19 October 2006 appealing from the Office action mailed 18 April 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

The grounds of rejection under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,781,515 to Pantet in view of U.S. Patent 5,540,367 to Kauker applies to claims 1-4, 6, 7, 9, 12-14, 16, and 17, which claims include the three independent claims 1, 6, and 16.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,781,512	Pantet	6-1998
5,540,367	Kauker	7-1996
6,751,164	Sekiguchi	6-2004
6,801,476	Gilmour	10-2004
4,022,014	Lowdenslager	5-1977

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6, 7, 9, 12-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pantet, US 5,781,512 (hereinafter Pantet) in view of Kauker, US 5,540,367 (hereinafter Kauker).

- a. Regarding claim 1:

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Pantet teaches a timepiece comprising: a casing (11, Fig. 1); a display device (3, Fig. 1) secured by the casing; and an attachment section (12, Fig. 1) pivotally attached to the casing; and wherein the attachment section is configured to be attachable to an object of interest (“a buckle or a small chain snap hook”, col. 2, ll. 50-51) wherein the attachment section is configured to pivot (“pivot the hinge”, col. 2, ll. 53-57) in a position to maintain the display device in a substantially upright position when the attachment section is placed on a substantially horizontal surface (Fig. 2).

Pantet does not teach wherein the attachment is a clip.

Kauker teaches a loop watch, including a hanger (14, Fig. 1), comprising a carabiner clip (14c, 14d, Fig. 1). Such a clip is very functional and allows the watch to be attached to a wide variety of belongings such as backpacks, golf bags and any other attachable article (col. 1, ll. 40-42), while not obstructing the hands and making the watch readily visible on various articles of both men’s and women’s clothing (col. 1, ll. 18-22).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Pantet to include the Kauker carabiner clip in the attachment section, because Kauker teaches that a carabiner clip is very functional and allows the watch to be attached to a wide variety of belongings such as backpacks, golf bags and any other attachable article, while not obstructing the hands and making the watch readily visible on various articles of both men’s and women’s clothing.

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b. Regarding claim 2, the combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 1 above. Pantet also teaches wherein the display device comprises a watch module (“pocket and table watch”, col. 3, l. 22).

c. Regarding claim 3, the combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 2 above. Pantet also teaches wherein the watch module includes one or more modes selected from a group consisting of a time mode (display elements 6 show the time, Fig. 1).

d. Regarding claim 4, the combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 1 above. Kauker also teaches wherein the clip comprises a carabiner clip (14c, Fig. 1).

e. Regarding claim 6:

Pantet teaches an attachable display apparatus comprising: a casing (11, Fig. 1) configured to hold (“secured to the case in a removable manner”, col. 2, ll. 35-36) an electronic device having a display; and a stand (12, Fig. 1) coupled to the casing, and configured to attach and detach with an object of interest (“a buckle or a small chain snap hook”, col. 2, ll. 50-51); wherein the casing and the stand are coupled such that they move with respect to each other and can be configured to lie essentially in the same plane to form a first configuration (Fig. 1) and can be configured to form an angle of ninety degrees or less between the stand and the casing to form a second configuration (Fig. 2; “pivot the hinge”, col. 2, ll. 53-57).

Pantet does not teach the stand having at least a portion thereof formed as a clip.

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Kauker teaches a loop watch, including a hanger (14, Fig. 1), comprising a carabiner clip (14c, Fig. 1). Such a clip is very functional and allows the watch to be attached to a wide variety of belongings such as backpacks, golf bags and any other attachable article (col. 1, ll. 40-42), while not obstructing the hands and making the watch readily visible on various articles of both men's and women's clothing (col. 1, ll. 18-22).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Pantet to include the Kauker carabiner clip in the attachment section, because Kauker teaches that a carabiner clip is very functional and allows the watch to be attached to a wide variety of belongings such as backpacks, golf bags and any other attachable article, while not obstructing the hands and making the watch readily visible on various articles of both men's and women's clothing.

f. Regarding claim 7, the combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 6 above. Pantet also teaches an electronic device ("watches of this type are marketed by Swatch AG, Bienne (Switzerland) under the brand name POP Swatch and are intended to be mounted..., " col. 3, ll. 33-36).

g. Regarding claim 9, the combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 6 above. Kauker also teaches wherein the clip comprises a carabiner clip (14c, Fig. 1).

h. Regarding claim 12, the combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 6 above. Pantet also teaches a hinge section (13, Fig. 1) configured to connect the stand with the casing in a pivoting manner.

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i. Regarding claim 13, the combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 7 above. Pantet also teaches wherein the casing configured to hold ("secured to the case in a removable manner", col. 2, ll. 35-36) an electronic device that includes a multi-function module configured to identify and display an altitude, a temperature, a time, a date, and a compass heading.

j. Regarding claim 14, the combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 6 above. Pantet also teaches wherein the second configuration maintains the display in an upright position while the stand is placed on a substantially horizontal surface (Fig. 2, col. 2, ll. 53-57).

k. Regarding claim 16:

Pantet teaches an apparatus comprising: an electronic device (3, Fig. 1; "watches of this type are marketed by Swatch AG, Bienne (Switzerland) under the brand name POP Swatch and are intended to be mounted...", col. 3, ll. 33-36) having a display (5, Fig. 1); a casing (11, Fig. 1) configured to hold the electronic device; and an attachment section (12, Fig. 1) pivotally attached to the casing, the attachment section configured to be attachable to an object of interest, the attachment section configured to be pivoted to form a stand for the apparatus (Fig. 2).

Pantet does not teach a clip pivotally attached to the casing, the clip configured to be attachable to an object of interest, the clip configured to be pivoted to form a stand for the apparatus.

Kauker teaches a loop watch, including a hanger (14, Fig. 1), comprising a carabiner clip (14c, Fig. 1). Such a clip is very functional and allows the watch to be attached to a wide variety

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of belongings such as backpacks, golf bags and any other attachable article (col. 1, ll. 40-42), while not obstructing the hands and making the watch readily visible on various articles of both men's and women's clothing (col. 1, ll. 18-22).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Pantet to include the Kauker carabiner clip in the attachment section, because Kauker teaches that a carabiner clip is very functional and allows the watch to be attached to a wide variety of belongings such as backpacks, golf bags and any other attachable article, while not obstructing the hands and making the watch readily visible on various articles of both men's and women's clothing.

1. Regarding claim 17, the combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 16 above. Pantet also teaches wherein the electronic device is a watch (3, Fig. 2).

3. Claims 5, 8, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pantet in view of Kauker as applied to claims 2, 7 and 16 above, and further in view of Sekiguchi, US 6,751,164 (hereinafter Sekiguchi).

a. Regarding claim 5:

The combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 2 above.

The combination of Pantet and Kauker does not teach a temperature sensor coupled to the watch module and wherein the display device is operable to display a temperature.

Sekiguchi teaches a watch configured to display a temperature (29, Fig. 8).

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify Pantet to include a temperature measurement and display function as taught by Sekiguchi, because a person having ordinary skill in the art would recognize that the addition of this feature would increase the functionality of the watch, thereby possibly increasing the commercial profitability of the watch.

b. Regarding claim 8:

The combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 7 above. Pantet also teaches wherein the electronic device comprises a watch module (5, Fig. 1) that includes a time mode.

The combination of Pantet and Kauker does not teach one or more modes selected from the group consisting of an altimeter mode.

Sekiguchi teaches a watch configured to display one or more modes selected from the group consisting of an altimeter mode ("using the timepiece as an altimeter," col. 4, ll. 9-13).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify Pantet to include an altimeter mode as taught by Sekiguchi, because a person having ordinary skill in the art would recognize that the addition of this feature would increase the functionality of the watch, thereby possibly increasing the commercial profitability of the watch.

c. Regarding claim 10:

The combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 8 above.

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The combination of Pantet and Kauker does not teach a temperature sensor coupled to the watch module and wherein the watch module is operative to display an ambient temperature.

Sekiguchi teaches a watch configured to display a temperature (29, Fig. 8), and a temperature sensor (7, Fig. 3; col. 9, ll. 39-42).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify Pantet to include a temperature sensor coupled to the watch module and wherein the watch module is operative to display an ambient temperature as taught by Sekiguchi, because a person having ordinary skill in the art would recognize that the addition of this feature would increase the functionality of the watch, thereby possibly increasing the commercial profitability of the watch.

d. Regarding claim 18:

The combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 16 above.

The combination of Pantet and Kauker does not teach wherein the electronic device comprises an altimeter.

Sekiguchi teaches a watch configured to display one or more modes selected from the group consisting of an altimeter mode ("using the timepiece as an altimeter," col. 4, ll. 9-13).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify Pantet to include an altimeter mode as taught by Sekiguchi, because a person having ordinary skill in the art would recognize that the addition of

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this feature would increase the functionality of the watch, thereby possibly increasing the commercial profitability of the watch.

4. Claims 11, 15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pantet in view of Kauker as applied to claims 7 and 16 above, and further in view of Gilmour, US 6,801,476 (hereinafter Gilmour).

a. Regarding claims 11 and 19:

The combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claims 7 and 16 above.

The combination of Pantet and Kauker does not teach wherein the electronic device comprises a personal audio device.

Gilmour teaches a wrist-worn phone and body-worn data storage device, including a personal audio device (MP3 music player, col. 7, l. 44).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify Pantet to include a personal audio device as taught by Gilmour, because a person having ordinary skill in the art would recognize that the addition of this feature would increase the functionality of the watch, thereby possibly increasing the commercial profitability of the watch.

b. Regarding claims 15 and 20:

The combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claims 7 and 16 above.

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The combination of Pantet and Kauker does not teach wherein the electronic device comprises a radio communication device.

Gilmour teaches a wrist-worn phone and body-worn data storage device, including a radio communication device (col. 4, ll. 17-18).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify Pantet to include a radio communication device as taught by Gilmour, because a person having ordinary skill in the art would recognize that the addition of this feature would increase the functionality of the watch, thereby possibly increasing the commercial profitability of the watch.

c. Regarding claim 21:

The combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 16 above.

The combination of Pantet and Kauker does not teach wherein the electronic device comprises a digital camera.

Gilmour teaches a wrist-worn phone and body-worn data storage device, including a digital camera ("digital camera", col. 7, l. 46).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify Pantet to include a digital camera as taught by Gilmour, because a person having ordinary skill in the art would recognize that the addition of this feature would increase the functionality of the watch, thereby possibly increasing the commercial profitability of the watch.

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5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pantet in view of Kauker as applied to claim 16 above, and further in view of Lowdenslager, US 4,022,014 (hereinafter Lowdenslager).

a. Regarding claim 22:

The combination of Pantet and Kauker teaches all that is claimed as discussed in the rejection of claim 16 above.

The combination of Pantet and Kauker does not teach wherein the electronic device comprises a calculator.

Lowdenslager teaches a combination wristwatch/calculator (Fig. 2) that adds the functionality to perform various arithmetic functions such as recording expenditures in a supermarket, balancing a checkbook stub, or checking inventories (col. 1, ll. 65-68).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify Pantet to include a calculator as taught by Lowdenslager, because Lowdenslager teaches that a calculator adds the functionality to perform various arithmetic functions such as recording expenditures in a supermarket, balancing a checkbook stub, or checking inventories, and a person having ordinary skill in the art would recognize that the addition of this feature would increase the functionality of the watch, thereby possibly increasing the commercial profitability of the watch.

(10) Response to Argument

1. It appears that appellant's arguments address a combination of the Kauker reference with the Pantet reference that is different from that proposed by the examiner, and which the examiner

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is not relying on in the above rejections of the claims. Before responding to appellant's specific arguments, the examiner would like to emphasize that the proposed combination of Pantet and Kauker set forth in the rejections above is simply the addition of a carabiner clip, as taught by Kauker, into the attachment section of Pantet. The attachment section of Pantet ("second part" 12 of support device 2, Fig. 1) has the same rectangular shape as the hanger 14 (Fig. 1) taught by Kauker. The hanger 14 of Kauker includes a carabiner clip (14c, 14d, Fig. 1) in one of the four sides of the rectangle. The examiner's proposed combination of Kauker with Pantet would simply place a carabiner clip in one of the four sides of the rectangular attachment section of Pantet.

2. Appellant argues on pp. 5-8 that there is no proper motivation to combine the references of Pantet and Kauker. The examiner disagrees. A suggestion, teaching, or motivation to combine prior art references may be found explicitly or implicitly in the teachings of the prior art, the nature of the problem to be solved, and the knowledge of persons of ordinary skill in the art, MPEP § 2143.01. In rejecting the claims under 35 U.S.C. § 103(a) as unpatentable over Pantet in view of Kauker, the examiner has set forth an explicit motivation to combine found in the teachings of the prior art. Kauker teaches that the carabiner clip is very functional and allows the watch to be attached to a wide variety of belongings such as backpacks, golf bags and any other attachable article (col. 1, ll. 40-42), while not obstructing the hands and making the watch readily visible on various articles of both men's and women's clothing (col. 1, ll. 18-22).

a. Appellant argues on p. 6 that because Pantet already includes a snap hook (40, Fig. 1), Pantet teaches away from the proposed motivation that "it to be easily attached to a wide variety

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of objects.” The examiner disagrees, and fails to see the logic of the appellant’s argument. A person having ordinary skill in the art would recognize that the proposed modification of adding the Kauker carabiner clip to the Pantet attachment section would enhance the functionality of the Pantet watch by allowing it to attach to objects without the need of the snap-hook. Pantet provides no explicit teaching away from the addition of a carabiner clip to enhance functionality, nor would a person having ordinary skill in the art find that the functionality of the Pantet device would be harmed by the addition of a carabiner clip.

b. Appellant argues on p. 6 that because Kauker teaches that the pocket watch passed out of vogue in the 20th century, the very premise of both the Kauker and Pantet references teach away from the combination of the references. The argument appears to be an unsupported opinion of the appellant, as a person having ordinary skill in the art, when confronted with the Pantet and Kauker references, would be motivated to make the combination proposed in the rejection of the claims above, regardless of how stylish or in vogue pocket watches are. Further, the premise of each reference appears to be the same: the hanging of a watch from various articles.

c. Appellant argues on pp. 6-7 that the proposed modification of the Pantet pocket watch with the carabiner clip of Kauker is expressly contrary to the teachings of Pantet because Pantet discloses that the primary goal of the invention is to fit easily or conveniently into a pocket of a garment and to not be bulky. The examiner fails to see how simply making one of the four sides of the Pantet attachment section 12 into a carabiner clip as taught by Kauker would make the Pantet watch any more bulky or any less able to fit easily or conveniently into a pocket of a garment. Appellant further argues that adding a carabiner clip to Pantet would apparently double

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the weight/bulk of the resultant pocket watch. The examiner fails to see how simply making one of the four sides of the Pantet attachment section 12 into a carabiner clip would double the weight/bulk of the resultant pocket watch, as it would appear that adding a carabiner clip would not change the size/weight of the Pantet watch at all, or only negligibly.

d. Appellant argues on p. 8 that there does not appear to be any motivation for the skilled artisan to redesign and reconstruct the device of Pantet to result in a watch that is easily attached to a wide variety of objects because Kauker already disclosed such a device without need for redesigning the device disclosed by Pantet. This argument cannot be successful, because if it were, it would completely eviscerate the very premise of §103(a). In a rejection based on a combination of references, a secondary reference will necessarily teach structure or functionality that the primary reference fails to teach. The factual inquiries under a §103(a) analysis are designed to determine whether it would be obvious to combine the teachings of two references, not whether it would make more sense to simply use the device of the second reference to perform a desired function. It is the combination of features of the two references that one must evaluate, and the fact that one reference already teaches a feature can not be used as evidence that there is no motivation to combine that feature with the teachings of another reference.

e. In response to appellant's argument on p. 8 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As discussed in the above rejections of the claims, Kauker provides explicit motivation (such a clip is very functional and allows the watch to be attached to a wide variety of belongings such as backpacks, golf bags and any other attachable article (col. 1, ll. 40-42), while not obstructing the hands and making the watch readily visible on various articles of both men's and women's clothing (col. 1, ll. 18-22)) for a person having ordinary skill in the art to make the combination proposed by the examiner.

3. Appellant argues on pp. 9-10 that the combination of Pantet and Kauker fails to teach or suggest the limitations present in appellant's claims. More specifically, the appellant argues that the combination of Pantet and Kauker fails to teach or suggest a clip pivotally attached to the casing, the clip configured to be attachable to an object of interest, the clip configured to be pivoted in a position to maintain the display device in a substantially upright position when the clip is placed on a substantially horizontal surface or form a stand for the apparatus. The examiner disagrees. The appellant appears to be arguing against a combination of Pantet and Kauker that would include the flexible strap 15 (Fig. 1) of Kauker. This is not the combination proposed by the examiner in the above rejections of the claims. Instead, the examiner is proposing to combine Kauker's teaching of a carabiner clip 14c (Fig. 1) in one of the four sides of rectangular piece 14 (Fig. 1) with the rectangular attachment piece 12 (Fig. 1) of Pantet. Such a combination would still allow the device of Pantet to "maintain the display device in a substantially upright position when the clip is placed on a substantially horizontal surface or form a stand for the apparatus," as one can see in Fig. 2 of Pantet that adding a carabiner clip into

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attachment piece 12 would not appear to affect the ability of the Pantet device to provide a stand for the watch.

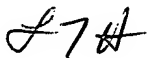
4. Appellant argues on pp. 11-12 that the claims are not rendered unpatentable by the combination of Pantet in view of Kauker in further view of Sekiguchi, Gilmour, or Lowdenslager, because the rejections of claims 5, 8, 10, and 18 (Sekiguchi), claims 11, 15, and 19-21 (Gilmour), and claim 22 (Lowdenslager) all rely on the allegedly improper combination of Pantet and Kauker. The examiner disagrees, and has set forth in the rejection of the claims and the arguments above the reasons why the combination of Pantet and Kauker is proper. Because the combination of Pantet and Kauker properly sets forth a *prima facie* case of obviousness, and because the additional secondary references also set forth *prima facie* cases of obviousness as discussed in the rejection of the claims above, the rejections of claims 5, 8, 10, 11, 15, and 18-21 are proper, and the claims are unpatentable.

(11) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Leo T. Hinze 

Conferees:

Judy Nguyen 

David Blum 



JUDY NGUYEN
SENIOR PATENT EXAMINER